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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/801,006

03/16/2004

Yoh Masuyama

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EXAMINER

GAMI, TEJAL

ART UNIT

PAPER NUMBER

2121

NOTIFICATION DATE

DELIVERY MODE

03/24/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/801,006	<b>Applicant(s)</b> MASUYAMA ET AL.	
	<b>Examiner</b> TEJAL J. GAMI	<b>Art Unit</b> 2121	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

1. This office action is responsive to an AMENDMENT entered November 29, 2007 for the patent application 10/801006.

### Status of Claims

2. Claims 1-18 were rejected in the last Office Action dated August 29, 2007.  
Claims 1-18 are now pending in this office action.

### *Information Disclosure Statement*

3. The information disclosure statement filed 07/29/2004 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; **(4) a column that provides a blank space next to each document to be considered, for the examiner's initials**; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-16 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Bala et al. (U.S. Publication Number: 2003/0018644).

**As to independent claim 1**, Bala discloses an image forming apparatus (e.g., graphical user interface) (see Paragraph [0044]), in which software (e.g., software system) is used for forming an image (see Paragraph [0044]), comprising:

a display unit (e.g., CRT display) (see Paragraph [0044]);

a display information controlling unit configured to control information displayed on said display unit (e.g., GUI) (see Paragraph [0044]);

an interface unit configured to provide a physical connection (Figure 1 network 100) with an external apparatus on which an application is implemented (e.g., client workstation supporting execution of a plurality of application programs such as a browser) (see Paragraph [0044] and [0069]);

a control unit (e.g., operating system) configured to control said interface unit and provide a logical connection with the external apparatus (e.g., I/O devices) (see Paragraph [0044]); and

a relay unit (e.g., client) (see Paragraph [0069]) configured to relay between the application and the software (see Paragraph [0041]), said relaying unit notifying said display information controlling unit of a display that is to be presented on said display unit to indicate ongoing preparation of the application until the application becomes operational when said control unit provides the logical connection with the external apparatus (e.g., ready for use by processes) (see Paragraph [0073]-[0074]).

**As to independent claim 18**, Bala discloses a method of allowing an external application (e.g., client workstation supporting execution of a plurality of application programs such as a browser) (see Paragraph [0044] and [0069]) to be operated through an image forming apparatus (e.g., graphical user interface) (see Paragraph [0044]) having a display unit (e.g., CRT display) (see Paragraph [0044]), the external application being implemented in an external apparatus connectable to the image forming apparatus (e.g., client workstation supporting execution of a plurality of application programs such as a browser) (see Paragraph [0044] and [0069]), said method comprising the steps of:

connecting the external apparatus to the image forming apparatus (Figure 1 network 100);

preparing a display that indicates ongoing preparation until the application becomes operational (e.g., ready for use by processes) (see Paragraph [0073]-[0074]);  
and

presenting the display on the display unit until the application becomes operational in response to an attempt by a user to use the application (e.g., ready for use by processes or users) (see Paragraph [0073]-[0074]).

**As to dependent claim 2**, Bala teaches the image forming apparatus as claimed in claim 1, wherein said display information controlling unit makes said display unit present said display in response to an attempt by a user to use the application (e.g., ready for use by processes or users) (see Paragraph [0073]-[0074]).

**As to dependent claim 3**, Bala teaches the image forming apparatus as claimed in claim 1, wherein said control unit notifies said relay unit that no communication is possible (e.g., authorization is verified), in response to a physical or logical (e.g., authorization) disconnection occurring with respect to the external apparatus (see Paragraph [0038]).

**As to dependent claim 4**, Bala teaches the image forming apparatus as claimed in claim 1, further comprising a starting unit configured to start said relay unit (e.g., startup) (see Paragraph [0041]).

**As to dependent claim 5**, Bala teaches the image forming apparatus as claimed in claim 4, wherein said starting unit starts said relay unit (e.g., client) after the external apparatus is physically connected (e.g., connection) (see Paragraph [0041]).

**As to dependent claim 6**, Bala teaches the image forming apparatus as claimed in claim 4, wherein said starting unit utilizes said control unit to check whether the external apparatus is physically connected (e.g., connection) (see Paragraph [0041]).

**As to dependent claim 7**, Bala teaches the image forming apparatus as claimed in claim 1, further comprising a registering unit configured to register the application, such registration making the application operable through said image forming apparatus (see Paragraph [0093]).

**As to dependent claim 8**, Bala teaches the image forming apparatus as claimed in claim 7, wherein said registering unit unregisters the application in response to a request from said relay unit (see Paragraph [0095]).

**As to dependent claim 9**, Bala teaches the image forming apparatus as claimed in claim 8, wherein said relay unit requests said registering unit to unregister the application, such request being made in response to a notice from said control unit indicating that no communication is possible (see Paragraph [0095]).

**As to dependent claim 10**, Bala teaches the image forming apparatus as claimed in claim 8, wherein, when said registering unit unregisters the application (see Paragraph [0095]), said display information controlling unit switches the information displayed on said display unit to other information if the information displayed on said display unit is associated with the application (e.g., swapped) (see Paragraph [0095]).

**As to dependent claim 11**, Bala teaches the image forming apparatus as claimed in claim 10, wherein said other information is associated with the software (see Paragraph [0095]).

**As to dependent claim 12**, Bala teaches the image forming apparatus as claimed in claim 9, wherein said registering unit is configured to register the application

again if the external apparatus is reconnected after the application is unregistered (e.g., swapped) (see Paragraph [0095]).

**As to dependent claim 13**, Bala teaches the image forming apparatus as claimed in claim 4, further comprising a program unregistering unit which unregisters said relay unit by releasing a memory area in which a program of said relay unit is laid out (see Paragraph [0095]).

**As to dependent claim 14**, Bala teaches the image forming apparatus as claimed in claim 13, wherein said relay unit (e.g., client) (see Paragraph [0069]), responding to a notice from said control unit indicating that no communication is possible (e.g., computer network...shared) (see Paragraph [0069]), notifies said starting unit that the application is unregistered (see Paragraph [0095]), and requests said program unregistering unit to unregister the application (see Paragraph [0095]).

**As to dependent claim 15**, Bala teaches the image forming apparatus as claimed in claim 14, wherein said relay unit is restarted by said starting unit if the external apparatus is connected after said relay unit is unregistered (e.g., swapped) (see Paragraph [0095]).

**As to dependent claim 16**, Bala teaches the image forming apparatus as claimed in claim 3, wherein said relay unit (e.g., client) (see Paragraph [0069]), responding to a notice from said control unit indicating that no communication is possible during execution of the application (e.g., computer network...shared) (see Paragraph [0069]), notifies said display information controlling unit of a display that is to



be presented on said display unit to indicate error occurrence (see Paragraph [0011] and [0081]).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bala et al. (U.S. Publication Number: 2003/0018644) as applied to claim 3 above, and further in view of Kobata et al. (U.S. Patent Number: 7,051,003).

**As to dependent claim 17**, Bala teaches the image forming apparatus (e.g., graphical user interface) (see Bala: Paragraph [0044]) as claimed in claim 3, but does not mention email. Kobata teaches further comprising an email sending unit (e.g., notification 62) (see Kobata: Col. 5, Lines 54-67), wherein said relay unit (e.g., sending system 14) (see Kobata: Col. 5, Lines 54-67), responding to a notice from said control unit indicating that no communication is possible during execution of the application (e.g., on-line availability) (see Kobata: Col. 5, Lines 54-67), instructs said email sending unit to send email indicative of error occurrence to a predetermined mail address (e.g., assured of the on-line availability) (see Kobata: Col. 5, Lines 54-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made

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to have utilized email as taught by Kobata to the image forming apparatus of Bala because an e-mail message can serve as notification (see Kobata: Col. 5, Lines 56-60).

### ***Response to Arguments***

8. Applicant's arguments filed November 29, 2007 have been fully considered. The claims does not overcome the original art rejection and the arguments are not persuasive. The following are the Examiner's observations in regard thereto.

#### **Applicant Argues:**

Bala fails to teach or suggest an image forming apparatus including a relay unit "configured to relay between the application and the software, said relaying unit notifying said display information controlling unit of a display that is to be presented on said display unit to indicate ongoing preparation of the application until the application becomes operational when said control unit provides the logical connection with the external apparatus," as recited in independent Claim 1.

#### **Examiner Responds:**

Examiner is not persuaded. Patentability of apparatus claims depends on the structure, not on the use or purpose of that structure; see Catalina, 62 USPQ2d at 1785.

Apparatus claims must be structurally distinguishable from the prior art; see MPEP 2114. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29

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(CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

“[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). See office action above and Paragraph [0069] where Bala discloses a relay unit (e.g., client). Therefore, the prior art teaches the claims as written.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tejal J. Gami whose telephone number is (571) 270-1035. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert DeCady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Albert DeCady/  
Supervisory Patent Examiner, Art Unit 2121

/TJG/

